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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of: Sullivan
Serial No.: 08/784,224
Filing Date: January 16, 1997
Group Art Unit: 2765
Examiner: James Myhre
Title: KNOWLEDGE MANAGEMENT SYSTEM AND METHOD

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Esmarie A. Garland
Esmarie A. Garland

May 24, 1999
Date

Dear Sir:

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)(1)

Applicant has appealed to the Board of Patent Appeals and Interferences from the decisions of the Examiner mailed August 18 and November 25, 1998 finally rejecting Claims 1-28 in the above-identified patent application. Applicant filed an Appeal Brief on February 2, 1999. The Examiner mailed an Examiner's Answer on March 25, 1999. Applicant respectfully submits herewith this Reply Brief, in triplicate.

**A. THE EXAMINER'S ANSWER DOES NOT COMPLY WITH
37 C.F.R. § 1.192(d).**

The Examiner states that the Summary of Invention provided by the Applicant's Appeal Brief is "deficient because it does not provide a concise explanation of the invention." (Examiner's Answer, ¶ 5). The Examiner further states, "the rejection of Claims 1-28 stand or fall together because Appellant's Brief includes a statement that this grouping of claims does not stand or fall together but does not provide reasons in support thereof." (Examiner's Answer, ¶ 7). Not only does Applicant traverse the Examiner's substantive position regarding the summary of invention and grouping of claims provided by Applicant's Appeal Brief, but Applicant disagrees with the Examiner's procedures for raising these "deficiencies" in the Examiner's Answer.

37 C.F.R. § 1.192(d) provides that "if a brief is filed which does not comply with all the requirements of paragraph (c) of this section, Appellant will be notified of the reasons for noncompliance and provided with a period of one month within which to file an amended brief." Section 1206 of the Manual of Patent Examining Procedure (MPEP) provides that the Examiner should make such a notification in a "notification of noncompliance with 37 C.F.R. § 1.192(c)." By failing to provide a notification of noncompliance, the Examiner has deprived the Appellants of the opportunity to cure the cited "deficiencies" in an amended brief--a right clearly provided to the Appellant by 37 C.F.R. § 1.192(d). In telephone interviews subsequent to the mailing of the Examiner's Answer, Applicant raised these issues before the Examiner. The Examiner, however, indicated that the Applicant should respond to these cited "deficiencies" in Applicant's Reply Brief. Since Applicant was deprived the right to file an amended brief, Applicant requests consideration by the Board of Patent Appeals and Interferences of the following grouping of the claims.

Applicant respectfully requests that Claims 1-28 not be grouped to stand or fall together according to 37 C.F.R. § 1.192(c)(7). Although Applicant believes that the argument section of Applicant's Appeal Brief adequately explains why the claims of the group are believed to be separately patentable, as required by 37 C.F.R. § 1.192(c), Applicant herein explains why the claims of the group are believed to be separately patentable to reply to the Examiner's Answer. In so doing, Applicant provides a somewhat concise explanation of the invention. Applicant respectfully requests that Claims 1-3, 6-7, 11-12, 19, and 22 be considered as a group, Claims 4, 13, and 20 be considered as a group; Claims 5, 14, and 21 be considered as a group; Claims 8, 18, and 23 be considered as a group; Claims 9, 15, and 24 be considered as a group; Claims 17 and 26-28 be considered as a group; and Claims 10, 16, and 25 be considered as a group.

Claims 1-3, 6-7, 11-12, 19 and 22 are directed to the novel concepts of a knowledge matrix, knowledge items, and status information and are, therefore, separately patentable from the remaining claims. Claims 4, 13, and 20 are directed to the novel concepts of knowledge workers, needs associated with a knowledge worker, process items associated with a selected need, and data items associated with a selected need, and are therefore separately patentable from the remaining claims. Claims 5, 14, and 21 are directed to the novel concepts of status information on a step of a process item and status information on an instance of a data item, and are therefore separately patentable from the remaining claims. Claims 8, 18, and 23 are directed to personal profiles, default profiles, and knowledge worker views, and are therefore separately patentable from the remaining claims. Claims 9, 15, and 24 are directed to generating access statistics, and are therefore separately patentable from the remaining claims. Claims 17 and 26-28 are directed to pending modules and pending queues, and are therefore separately

patentable from the remaining claims. Claims 10, 16, and 25 are directed to modifying a personal profile of a knowledge worker in response to access statistics, and are therefore separately patentable from the remaining claims.

B. THE EXAMINER CITES NO PRIOR ART THAT ALONE OR IN COMBINATION SUGGESTS A KNOWLEDGE MATRIX THAT STORES STATUS INFORMATION ON A PLURALITY OF KNOWLEDGE ITEMS.

Applicant respectfully traverses the Examiner's position that "it is well known within the database art to use indices showing the type, status, and/or content of the items within the database in order to preclude the necessity of doing a full-text search of every item." (Examiner's Answer, Section B). When faced with repeated requests to produce specific references that teach the claim limitations that the Examiner concludes are obvious, the Examiner is unable to do so. Instead, the Examiner concocts an obviousness argument that impermissibly relies upon hindsight reconstruction. In doing so, the Examiner misunderstands the inventive concepts of Applicant's invention as embodied in Claim 1.

For example, the Examiner states that an "index shows the user not only what information is available, but also where it is located within the indexed resource." (Examiner's Answer, section B). The Examiner fails to appreciate the difference between an index that identifies or locates **existing** information as compared to "status information" that "indicates the **availability** of the knowledge items," as recited, in part, in Claim 1. Applicant respectfully notes that while a knowledge item may exist, it may not yet, for example, be available in the proper form or status. In this regard, Applicant draws a distinction between "existing" information and "available" information that the Examiner overlooks.

The Examiner's reference to a "work progress table" in *Oku* also fails to teach, suggest, or disclose "status information" as embodied in Claim 1. Claim 1 recites, in part, a "server comprising a knowledge matrix operable to store status information on a plurality of knowledge items associated with [a] first request, the server operable to generate a second request for the knowledge items if the status information stored in the knowledge matrix indicates the availability of the knowledge item." *Oku* fails to teach, suggest, or disclose at least these aspects of the claimed invention. On the contrary, *Oku* is limited to receiving user input characteristics of a "clinical trial" using the graphical user interfaces illustrated in Figures 45-49. (Column 21, line 41 through column 22, line 16). Based upon the user input, such as "theme name," "clinical trial name," "work group name," and "work name", the system of *Oku* retrieves a "work specification table" such as that displayed in Figure 50 of *Oku*. (Column 22, lines 17-29). One item in the work specification table that the user may select is a "work progress table" that illustrates a "network diagram" for the selected clinical trial, as illustrated in Figure 51 of *Oku*. (Column 22, lines 30-36). Therefore, the "work progress table" of *Oku* is the end result of a series of requests directed by the user to a specific "clinical trial," whereas the "status information" embodied in present Claim 1 instead "indicates the availability of a knowledge item." *Oku* does not "generate a second request for the knowledge items if the status information stored in the knowledge matrix indicates the availability of the knowledge item," as recited in Claim 1, because the "work progress table" of *Oku* simply cannot indicate the availability of a knowledge item. (Column 21, line 41 through Column 22, line 29).

C. THE EXAMINER CITES NO PRIOR ART THAT ALONE OR IN COMBINATION SUGGESTS NEEDS ASSOCIATED WITH A KNOWLEDGE WORKER, A PROCESS ITEM OR DATA ITEM ASSOCIATED WITH A SELECTED NEED, STATUS INFORMATION ON A STEP OF THE PROCESS ITEM, OR STATUS INFORMATION ON AN INSTANCE OF THE DATA ITEM.

The Examiner states that "[b]y being able to display the information pertaining to the user's need which includes data from these databases, *Oku* infers that the needs, process items, data items, etc. are associated (cross-referenced) with each other." (Examiner's Answer, section C). Applicant respectfully traverses the Examiner's position. The Examiner is essentially arguing that by locating and displaying the information "by document, by work progress, work group, etc.," (Examiner's Answer, section C), the *Oku* system is satisfying a request of the user. By merely satisfying a request of a user, the *Oku* system does no more than any other pedestrian data retrieval system that fails to teach, suggest, or disclose the claimed invention. In this respect, the Examiner again fails to appreciate the inventive concepts of Applicant's invention.

Claims 4 and 5 recite, in part, a "knowledge matrix" that comprises "a knowledge worker grid operable to identify a plurality of needs associated with the knowledge worker, the knowledge worker grid operable to relate the first request to a selected need ... a process grid operable to identify a process item associated with the selected need ... a data grid operable to identify a data item associated with the selected need." *Oku* fails to teach, suggest, or disclose at least a "knowledge worker grid operable to identify a plurality of needs associated with the knowledge worker, the knowledge worker grid operable to relate the first request to a selected need."

Claim 5 further recites, in part, "a process cycle grid operable to store status information on a step of the identified process item ... and a data cycle grid operable to store status information on an instance of the identified data item." As discussed above with regard to Claim 1, the "work progress" of *Oku* does not teach, suggest, or disclose "status information" as embodied in the claimed invention.

D. THE EXAMINER CITES NO PRIOR ART THAT ALONE OR IN COMBINATION SUGGESTS A PERSONAL PROFILE FOR A KNOWLEDGE WORKER AND A SELECTED KNOWLEDGE WORKER VIEW, AND A DEFAULT PROFILE ASSOCIATED WITH A CORRESPONDING KNOWLEDGE WORKER VIEW.

The Examiner combines two disparate references -- *Oku* and *Srinivasan* -- that provide no suggestion or motivation to combine. To combine prior art in an effort to establish a prima facie case of obviousness under 35 U.S.C. § 103, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP §2143. Additionally, the teaching or suggestion to make the asserted combination of prior art must be found in the prior art, not in the application's disclosure. MPEP §2143 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Neither *Oku* nor *Srinivasan*, alone or in combination, teach, suggest, or disclose the use of "personal profiles" or "default profiles," as embodied by the claimed invention. Faced with the limited teachings of his cited references, the Examiner performs many leaps of logic, such as basing his reliance of "client environments" in *Oku* upon the giving of certain "roles and privileges" in society, to arrive at a purported teaching of "personal profiles" and "default profiles." (Examiner's Answer, section D). Applicant respectfully traverses the Examiner's position.

Not only does the Examiner's analysis require assumptions not grounded or supported in the cited references, but the Examiner fails to consider each and every limitation of Applicant's pertinent claims. For example, Claim 8 recites, in part, "a plurality of personal profiles, each personal profile identified by a knowledge worker identifier that specifies the knowledge worker and a selected knowledge worker view ... and a plurality of default profiles, each default profile associated with a corresponding knowledge worker view." The *Oku-Srinivasan* combination fails to teach, suggest, or disclose at least a "knowledge worker identifier that specifies ... a selected knowledge worker view" as embodied by the claimed invention.

E. THE EXAMINER CITES NO PRIOR ART THAT ALONE OR IN COMBINATION SUGGESTS GENERATING ACCESS STATISTICS.

The Examiner relies on three disparate references -- *Oku*, *Srinivasan*, and *Barritz* -- that offer no motivation or suggestion to combine with any other references and which references fail, either alone or in combination, to teach, suggest, or disclose the claimed invention. A reference particularly relied upon by the Examiner, *Barritz*, is specifically limited to monitoring the instantiation of previously identified **executable** files. (Column 4, line 64 through column 5, line 18). In particular, *Barritz* discloses separating **executable** files, such as software programs, from **non-executable** files, such as databases, and monitoring only the **executable** files. (Column 4, line 64 through column 5, line 18). By limiting the scope of monitoring to the instantiation of executable files only, *Barritz* is inoperable "to generate access statistics" as recited in Applicant's claims.

The Examiner claims that "it would have been very obvious to one skilled in computer arts that one or more of the methods for capturing access statistics disclosed by *Barritz* could also have been used to capture statistics on accessing other types of files," but fails to cite any portion of *Barritz* (or any other reference) to support this supposedly obvious proposition. (Examiner's Answer, section E). Instead, the Examiner again relies on an "it-would-have-been-obvious" argument to support his impermissible hindsight reconstruction of the claimed invention.

F. THE EXAMINER CITES NO PRIOR ART THAT ALONE OR IN COMBINATION SUGGESTS A PENDING MODULE THAT IDENTIFIES AN UNAVAILABLE KNOWLEDGE ITEM AND A PENDING QUEUE THAT STORES INFORMATION ON THE UNAVAILABLE KNOWLEDGE ITEM.

At the outset, Applicant respectfully traverses the Examiner's position that *Oku* teaches a "pending matters" section. Despite the Examiner's tenuous arguments regarding the teachings of *Oku*, the fact remains that the Examiner again relies upon three disparate references -- *Oku*, *Barritz*, and *Srinivasan* -- that offer no motivation or suggestion to combine, and which references fail, either alone or in combination, to teach, suggest, or describe the claimed invention. For example, Claim 17 recites, in part, "a pending module coupled to the control module, the pending module operable to identify an unavailable knowledge item ... and a pending queue coupled to the pending module and operable to store information on the unavailable knowledge item." Contrary to the Examiner's suggestions, neither the "work progress table" of *Oku*, the monitoring system of *Barritz*, nor the notification function of *Srinivasan*, alone or in combination, teaches the claimed aspects of Applicant's invention. The *Oku-Barritz-Srinivasan* combination fails to

teach, suggest, or disclose, at least, identifying or storing information on an "unavailable knowledge item." Therefore, in an impermissible attempt to reject the claimed invention using hindsight reconstruction, the Examiner concocts another "it-would-have-been-obvious" argument that is not grounded in any teachings of the cited references.

G. THE EXAMINER CITES NO PRIOR ART THAT ALONE OR IN COMBINATION SUGGESTS MODIFYING A PERSONAL PROFILE IN RESPONSE TO ACCESS STATISTICS.

The Examiner relies on four disparate references -- *Oku*, *Srinivasan*, *Barritz*, and *Graves* -- that offer no motivation or suggestion to combine with any other references and which references fail, either alone or in combination, to teach, suggest, or disclose the claimed invention. Applicant respectfully observes that the Examiner adds another reference, *Graves*, that not only relates to the field of television media rather than "knowledge management," but also requires solicitation of the viewer particularly for the purposes of gaining viewer preferences. (Column 6, lines 55-56 and column 7, lines 37-43). To overcome these defects in his cited reference, the Examiner relies upon another "it-would-have-been-obvious" argument. In particular, the Examiner states that "[a]s discussed in Section E ... the system is already tracking user access statistics. It would have been obvious ... to use these statistics in place of soliciting similar data from the user when modifying the preference profile." (Examiner's Answer, page 15).

Recall the Examiner's discussion of access statistics, considered in section E above, also used an obviousness argument unsupported by the references. Therefore, the Examiner's current "it-would-have-been-obvious" argument is based upon a prior "it-would-have-been-obvious" argument. In this respect, the Examiner is layering subsequent obviousness

arguments upon a faulty foundation of previous obviousness arguments. The Examiner's reliance on this sort of multi-tiered "it-would-have-been-obvious" analysis is a clear indication of the hindsight reconstruction used by the Examiner to reject the claimed invention.

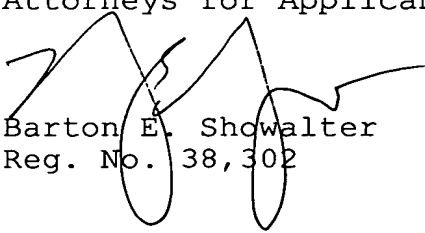
CONCLUSION

Applicant has clearly demonstrated that the present invention as claimed is distinguishable over the art cited of record, either alone or in combination. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Although no fee is believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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